

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: W. Scott THIELMAN and)
Robert M. PRICONE)
Serial No.: 10/015,319)
Filed: December 12, 2001)
For: A Process and Apparatus for)
Embossing Precise Microstructures)
and Embossing Tool for Making)
Same)
Group Art Unit: 1732)

Attorney Docket:
013013-026179



**STATEMENT OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NON-SIGNING INVENTORS UNDER 37 C.F.R. § 1.47(b)**

1. I, Janice Jackson, was an Administrative Assistant at Avery Dennison Corporation, the putative owner of the above-identified application, until April 30, 2002. I make this statement of facts in support of a petition to accept the above-identified application with the omission of an oath or declaration signed by both of the joint inventors, W. Scott Thielman and Robert M. Pricone, who refuse to sign an oath or declaration.

2. One of my responsibilities at Avery Dennison Corporation was to administer the docket of inventions and patent applications for the businesses located in Niles and Mt. Prospect, Illinois. I also coordinated obtaining necessary signatures from inventors located in the area even though the applications may have related to other business components of the company.

ROBERT M. PRICONE

3. Inventor Robert M. Pricone is a former employee of Avery Dennison Corporation and its predecessor in interest the Stimsonite Corporation, and was employed by them from November 7, 1977 to October 5, 2001. A copy of his relevant employment documents are attached as Exhibit A-1 and A-2.

4. As part of my duties, I called Mr. Pricone's home on January 23, 2002 and told him that I intended to send the above-titled patent application and the formal papers to his home for his review and signature. Mr. Pricone agreed to look at the documents.

5. On January 24, 2002, I sent via Federal Express to Mr. Pricone's home in Libertyville, Illinois a copy of the patent application (including the specification, claims and drawings), a Combined Declaration and Power of Attorney for Patent Application ("Declaration") and an assignment document ("Assignment") relating to the present application, all of which papers were prepared by the law firm of Jones, Day, Reavis & Pogue. I requested that he review the patent application, sign the Declaration and Assignment, and return the executed documents to my attention. I also instructed him to contact me at my office if he had any questions or concerns. I included a note in the Federal Express package asking Mr. Pricone to notify me if he did not intend to return the signed Declaration to me within two weeks. I also advised Mr. Pricone that I would notarize his signature when he signed the Assignment. To my knowledge, Mr. Pricone never replied to these requests. A copy of the Federal Express receipt from this mailing is attached as Exhibit B.

6. On February 11, 2002, I called Mr. Pricone at his home phone number and asked him to return the signed papers to me. Mr. Pricone stated that he was not going to return the signed papers until he received a response to an e-mail that he had sent to Mr. Arthur Moore (Avery Dennison's Chief Patent Counsel) during the week of February 6, 2002.

7. One month later, on March 11, 2002, I sent Mr. Pricone an e-mail asking him when he would be returning the signed papers. Mr. Pricone did not reply to my e-mail. A copy of the March 11 e-mail is attached as Exhibit C.

8. On March 13, 2002, I called Mr. Pricone's home and left a message on his machine stating that I needed the signed Declaration so that the patent application process could move forward. Mr. Pricone did not respond to this phone call.

9. On March 15, 2002, I sent an e-mail Mr. Moore telling him that Mr. Pricone had not responded to any of my telephone messages or e-mails. Mr. Moore told me to discontinue my efforts to obtain Mr. Pricone's signed papers, and that Ronald A. Sandler, patent counsel from Jones, Day, Reavis & Pogue, would try to handle the matter. I was informed that Mr. Sandler also was unsuccessful in having Mr. Pricone sign the formal papers.

10. The last known address of Robert M. Pricone is 31175 Bob-O-Link Lane, Libertyville, Illinois 60648.

W. SCOTT THIELMAN

11. Inventor W. Scott Thielman was an employee of Stimsonite Corporation, Avery Dennison Corporation's predecessor in interest, from April 21, 1993 to January 29, 1999. He signed a "Noncompetition, Invention and Secrecy Agreement" with Stimsonite on April 21, 1993. This agreement is attached as Exhibit D. Thereafter, Mr. Thielman, through his company Material Testing Technology Company, provided paid consulting services on several projects for Avery Dennison, and Mr. Thielman continued to act as a consultant to Avery Dennison throughout the relevant period.

12. As part of my duties, on January 24, 2002, I sent via Federal Express to Mr. Thielman's home in Palatine, Illinois a copy of the patent application (including the specification, claims and drawings), a Combined Declaration and Power of Attorney for Patent Application ("Declaration") and an assignment document ("Assignment") relating to the present application, all of which papers were prepared by the law firm of Jones, Day, Reavis & Pogue. I requested that he review the patent application, sign the Declaration and Assignment, and return the executed documents to my attention. I also instructed him to contact me at my office if he had any questions or concerns. I included a note in the Federal Express package asking Mr. Thielman to contact me if he did not intend to return the signed Declaration and Assignment within two weeks. I also stated that I would notarize his signature when he signed the Assignment. To my knowledge, Mr. Thielman never replied to these requests. A copy of the Federal Express receipt from this mailing is attached as Exhibit E.

13. On February 11, 2002, I called Mr. Thielman's home telephone number of 630/521-1773 but received a message that the number was no longer in service.

14. Also on February 11, I talked to Mr. Pricone on the telephone, and Mr. Pricone gave me the telephone number of 847/ 525-0644, that he thought I could use to contact Mr. Thielman. On the same day I tried to contact Mr. Thielman by calling that number. Nobody answered these calls, and no answering machine responded.

15. I have been unable to contact Mr. Thielman since I sent him the patent application and other formal documents on January 24, 2002, and Mr. Thielman has not contacted me.

16. Mr. Thielman's last known address is 840 North Martin Drive, Palatine, IL 60067.

17. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the present application or any patent issued thereon.

Dated: May 23, 2002

By: Janice Jackson
Janice Jackson
Administrative Assistant